

ESTTA Tracking number: **ESTTA619766**Filing date: **08/06/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	J.B. Marketing International, Inc.
Granted to Date of previous extension	08/06/2014
Address	4924 BALBOA BLVD., SUITE 459 ENCINO, CA 91316 UNITED STATES
Attorney information	Tal Grinblat Lewitt, Hackman, Shapiro, Marshall & Harlan 16633 Ventura Blvd., Suite 1100 Encino, CA 91436 UNITED STATES tgrinblat@lewitthackman.com, nkanter@lewitthackman.com Phone:818-990-2120

Applicant Information

Application No	77555704	Publication date	04/08/2014
Opposition Filing Date	08/06/2014	Opposition Period Ends	08/06/2014
Applicant	da Vinci Kunstlerpinselfabrik Defet GMBH Tillystrasse 39-41 NÄ¼rnberg, D90431 GERMANY		

Goods/Services Affected by Opposition

Class 021. First Use: 1988/00/00 First Use In Commerce: 1988/00/00
All goods and services in the class are opposed, namely: cosmetic and shaving brushes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DA VINCI		
Goods/Services	Cosmetic brushes		

Attachments	Notice of Opposition.pdf(31566 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Nicholas Kanter
Name	Nicholas Kanter
Date	08/06/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:

J.B. MARKETING INTERNATIONAL,
INC.,

Opposer

v.

DA VINCI
KUNSTLERPINSELFABRIK DEFET,
GMBH

Applicant

Opposition No.

NOTICE OF OPPOSITION

Application Serial No. 77/555,704
Mark: da vinci & Design
Filed: August 26, 2008
Published: April 8, 2014

J.B. MARKETING INTERNATIONAL, INC. (“Opposer”), a corporation organized and existing under the laws of California with a principal place of business at 4924 Balboa Blvd., Suite 459, Encino, CA 91316, believes it will be damaged by the issuance of a registration for the trademark shown in Application Serial No. 77/555,704 and hereby opposes the same.

As grounds for its opposition, Opposer alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. Opposer is a cosmetics company based in Los Angeles, California. Opposer manufactures, distributes and sells in interstate commerce cosmetic brushes under the brand **DA VINCI** (“Opposer’s Mark”). Opposer is the senior user of **DA VINCI** in connection with cosmetic brushes in the United States.

2. On August 26, 2008, Applicant de Vinci Kunstlerpinselfabrik Defet GMBH (“Applicant”) filed Application Serial No. 77/555,704 (the “Application”) based on an intent-to-use basis to register the mark shown immediately below (hereinafter referred to as “Applicant’s Mark”):

da vinci

3. Applicant applied to register Applicant's Mark in International Class 021 for "cosmetic and shaving brushes."

COUNT 1 – FRAUD

4. Opposer repeats and incorporates by reference its allegations in Paragraphs 1 through 3 as if set forth in full herein.

5. *Six years* after filing its Application on an intent-to-use basis, Applicant filed an Amendment to Allege Use, alleging a first use date of 1988. This alleged first use date is *twenty years* before the filing date of the Application.

6. On September 26, 2013, Applicant provided Opposer with documents purporting to show use of Applicant's Mark in the United States in connection with cosmetic brushes. The earliest date reflected on these documents is 1997 – *nine years* after to the first use date alleged in the Amendment to Allege Use.

7. Prior to 1997, Applicant sold cosmetic brushes in interstate commerce under a trademark different and distinct from Applicant's Mark. Also, Applicant's sales in the United States were so sporadic and minimal as to not constitute bona fide trademark use.

8. Based on the foregoing, the first use date stated in Applicant's Amendment to Allege Use is false. When Applicant signed the Amendment to Allege Use and filed the Amendment to Allege Use with the Trademark Office, Applicant knew the alleged date of first use was false. Alternatively, Applicant should have known that the date of first use in the Amendment to Allege Use was false. In addition, because Applicant's use of Applicant's Mark after 1997 was so nominal, such use could not and does not constitute use in interstate commerce sufficient to establish protectable trademark rights in Applicant's Mark.

9. The Amendment to Allege Use was signed by Hermann Meyer, Applicant's Corporate Executive Officer, on January 15, 2014. Applicant filed the Amendment to Allege Use with the intent to deceive the Trademark Office into accepting the first use date set forth therein as the true and correct first date of use.

10. Based on the foregoing, Applicant's Application is void *ab initio* and registration

of Applicant's Mark should be denied.

COUNT II – LIKELIHOOD OF CONFUSION

11. Opposer repeats and incorporates by reference its allegations in Paragraphs 1 through 10 as if set forth in full herein.

12. Opposer's Mark and Applicant's Mark are virtually identical in appearance, sound and commercial impression. There is also direct overlap between the parties' products – i.e., cosmetic brushes.

13. Because the parties' marks are virtually identical and the parties' products directly overlap, there is a risk that consumers will continue to mistake Opposer's products for those of Applicant, and vice versa. There have already been instances of actual confusion where consumers have mistaken Applicant's products for those of Opposer. As the senior user of **DA VINCI** for cosmetic brushes in the United States, Opposer has superior rights in and to **DA VINCI** over Applicant.

14. Because Opposer is the senior user of **DA VINCI** for cosmetic brushes, Opposer has the right to enjoin junior users, such as Applicant, from using confusingly similar marks, such as Applicant's Mark, in connection with cosmetic brushes.

15. Alternatively, even if Applicant first used Applicant's Mark before Opposer first used **DA VINCI** for cosmetic brushes (which Opposer denies), Applicant's use of Applicant's Mark has been too minimal to constitute trademark use in interstate commerce. Moreover, Applicant has not used Applicant's Mark continuously since the first use date stated in the Amendment to Allege Use. Accordingly, Opposer has superior rights in the **DA VINCI** mark over Applicant.

16. Based on the foregoing, Applicant's use of Applicant's Mark is likely to continue to cause confusion, mistake or deception in the minds of consumers as to the origin of Applicant's goods and services in violation of Section 2(d) of the Lanham Act, 15, U.S.C. §1052(d), with consequent injury to Opposer and the public.

WHEREFORE, Opposer requests that this opposition be sustained and that the registration of Application Serial No. 77/555,704 be denied.

DATED: August 6, 2014

LEWITT, HACKMAN, SHAPIRO,
MARSHALL & HARLAN

By: /s/ Nicholas Kanter
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CERTIFICATE OF SERVICE

It is hereby certified that on August 6, 2014, a copy of the foregoing NOTICE OF OPPOSITION has been sent by First Class, prepaid, United States Postal Service to da Vinci Kunstlerpinselfabrik Defet GMBH, via its attorney of record, at the address below:

Margaret Mchugh, Esq.
Kilpatrick Townsend & Stockton LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3833

/s/ Nicholas Kanter
Nicholas Kanter